

### **REMARKS/ARGUMENTS**

This amendment responds to the Office Action dated March 20, 2006.

The Examiner indicated that claim 10 patentably distinguishes over the cited prior art and would be allowable if rewritten in independent form. The applicant has amended claim 1, from which claim 10 depends, to distinguish over the cited reference; therefore, the applicant respectfully argues that claim 10 is allowable in its present form.

The Examiner objected to claims 1 and 3, contending that the claim term “capable of” is “not a limitation in any patentable sense.” The Examiner required that claim 1 be amended to replace that term with “for” and to eliminate the term from claim 4. At the outset, the applicant disagrees with the contention that the term “capable of” does constitute a positive limitation to the claim, as even the Examiner concedes that it “*requires* the ability to perform” the function following the term. For example, a claim to a mechanical apparatus reciting the sole limitation of “a structural member having an upper surface and capable of supporting a car weighing 5000 pounds” would read on a flatbed rail car, but not on a dinner table. Therefore, the term “capable of” must have some patentable meaning since it reads on some prior art but excludes other prior art. The authority cited by the Examiner simply notes that, using the same example, *a car weighing 5000 pounds* is not a positive element in the hypothetical claim recited above. Accordingly, the Examiner lacks the authority to require applicant to amend the claims to include narrower limitations beyond that required to distinguish over the prior art. *See, e.g.* MPEP § 2106 II C; *Id* § 2111.04 (each stating that terms such as “adapted to” simply raise issues as to how the Examiner interprets the scope of the claim).

Nonetheless, with respect to independent claim 1, applicant has amended the claim to recite the limitation of “a second platen supporting an optical probe for testing optical components on said device under test.” With respect to claim 4, applicant has retained the limitation of “wherein said first platen and said second platen are capable of relative movement

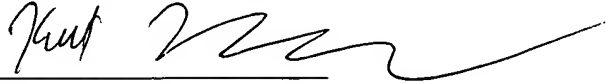
with respect to one another” for two reasons. First, to simply delete the term “capable of” as suggested by the Examiner would render the claim objectionable because it would not make sense grammatically. Second, were the applicant to amend the claim to recite, for example, “wherein said first platen and said second platen move relative to one another” then the claim would be too restrictive, as it might imply that the claim requires the platens to actually move during testing. This is not what is intended to be claimed.

The Examiner rejected claims 1-9 under 35 U.S.C. § 102(b) as being anticipated by Palkuti, U.S. Patent No. 4,575,676. Independent claim 1, as amended, recites the limitations of “a second platen supporting an optical probe for testing optical components on said device under test” and “said first platen positioned above said second platen and said second platen positioned above said device under test.” Neither of these limitations is disclosed by the cited reference. First, the element 21, which the Examiner considers the claimed “second platen supporting an optical probe” is positioned above the first platen 31, and not vice versa, as claimed. The applicant also notes that a cursory review of FIGS. 1 and 3 show that positions of the platens of Palkuti could not be reversed because (1) the collimators 19 and 33 are too bulky to be positioned below the electrical test apparatus and (2) the electrical test apparatus 47 could not probe the device-under-test in that configuration due to the intervening collimators 19 and 33. Second, the collimator 33 is not “for testing optical components on said device under test” as claimed. Instead, the collimators are merely intended to focus X-rays on electrical components such as bipolar and MOS transistors, so as to probe the test device under simulated, harsh conditions of ionizing radiation. Palkuti provides no disclosure that the characteristics of *optical* components change when subjected to ionizing radiation, such that testing under such conditions is desired. For each of these reasons, claims 1-9 patentably distinguish over the cited prior art.

Appl. No. 10/759,481  
Amdt. dated July 10, 2006  
Reply to Office Action of March 20, 2006

In view of the foregoing amendments and remarks, the applicant respectfully requests reconsideration and allowance of claims 1-10.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kurt Rohlfs', followed by a long, sweeping horizontal line.

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